

## REMARKS/ARGUMENTS

Reconsideration of the above-identified application is respectfully requested.

In the Office Action dated April 17, 2006, claims 10-16, 33-44 and 46-51 are pending. Claims 44 and 48-51 are under examination.

Claim 44 is objected to for a typographical error.

Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claims 44 and 48-51 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,227,163 to Eini et al. (hereinafter "Eini").

Claims 44 and 48-51 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or alternatively as being obvious over U.S. Pat. No. 5,759,556 to Burger et al. (hereinafter "Burger").

Claims 44 and 48-51 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or alternatively as being obvious over U.S. Pat. No. 6,020,288 to Nonomura et al. (hereinafter "Nonomura").

Claims 44 and 48-51 are rejected under 35 U.S.C. § 102(e) as being anticipated by, or alternatively as being obvious over U.S. Pat. Appl. No. 2002/0107292 to Bortlik et al. (hereinafter "Bortlik").

Applicants acknowledged the receipt of PTO-892.

In response to the objection and rejections, Applicants have amended claim 49 and cancelled claims 10-16, 33-44, 46, 47, and 50. The amendments are made to further clarify the claimed invention. No new matter has been introduced.

Applicants respectfully submit that the amendments have overcome the objection and rejections for the reasons set forth below:

**Claim objection**

Claim 44 is objected to for a typographical error. Because claim 44 is cancelled for other reasons, this issue is moot. Withdrawal of the objection to claim 44 is respectfully requested.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Because claim 44 is cancelled for other reasons, this issue is moot. Withdrawal of the rejection to claim 44 under 35 U.S.C. 112, second paragraph, is respectfully requested.

**Rejections Under 35 U.S.C. § 102**

Claims 44 and 48-51 are rejected under 35 U.S.C. § 102(b) as being anticipated by Eini for reasons stated on page 3-5 of the Office Action. Applicants respectfully traverse the rejections.

For anticipation under 35 U.S.C. §102, the reference “must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” (MPEP §706.02, IV. Distinction between 35 U.S.C. 102 and 103, page 700-21). The Federal Circuit has held that prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim (*Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, (Fed. Cir. 1985); *Atlas Powder Co. v. DuPont*; 750 F.2d 1569, (Fed. Cir. 1984); *American Hospital Suppl v. Travenol Labs*, 745 F.2d 1 (Fed. Cir. 1984).

Claim 49, as amended, recite “a topical pharmaceutical composition comprising a free base or a pharmaceutically acceptable salt of a dermal cytochrome 450 1A (CYP1A) inhibitor, a carrier for topical application, and a dermatological drug; wherein said dermal CYP1A inhibitor is terpineol and said dermatological drug is retinoic acid.”

Eini generally describes a composition for repelling lice. The composition does not contain retinoic acid. Accordingly, Applicants respectfully submit that Eini does not anticipate claim 49 because it fails to teach every aspect of the claimed invention. Applicants further submit that claim 51 is patentable over Eini because it depends from claim 49 and recites additional patentable subject matter. Withdrawal of the rejection 35 U.S.C. §102(b) over Eini is respectfully requested.

**Rejections Under 35 U.S.C. § 102/103**

Claims 44 and 48-51 are also rejected under 35 U.S.C. § 102(b)/(e) as being anticipated by, or alternatively as being obvious over Burger, Nonomura or Bortlik for reasons stated on pages 6-8 of the Office Action. Applicants respectfully traverse the rejection.

Burger generally describes a skin care composition comprising retinol, a cyclic aliphatic unsaturated compound, and a cosmetically acceptable vehicle. Burger does not disclose a composition comprising retinoic acid and terpineol, as recited in claim 49. Accordingly, Burger does not anticipate claim 49 because it fails to teach every aspect of the claimed invention.

With respect to the obviousness rejection, the Office action alleges that “one would have been clearly envisages the substitution with expectation of success, or at least

the substitution is readily apparent because US '556 clearly suggest that the efficacy of substitution is well anticipated, and thus, one would have been motivated to employ [sic] terpineol instead of ionone or methylinone .... with reasonable expectation of success."

Applicants respectfully disagree. Burger teaches that "[i]t is believed that the use of retinol or esters of retinol would be preferred over retinoic acid." (*see* col. 1, lines 27-28). In addition, Burger tested a number of cyclic aliphatic unsaturated compound for their inhibitory effect on ARAT and LRAT, and found that alpha terpineol is one of the compounds that are least effective in inhibiting ARAT and LRAT (*see e.g.*, col. 12, Table A). Therefore, Burger is actually teaching away from using retinoic acid. There would be no "reasonable expectation of success" for the substitution proposed by the Examiner (*i.e.*, substituting retinol with retinoid acid and ionone/methylinone with terpineol) because (1) Berger prefers retinol, not retinoic acid, and (2) terpineol is one of the least effective compounds for Berger's purpose.

Nonomura describes a plant growth enhancing system comprising an aqueous solution containing an oxidant and an aqueous solution containing a reductant. The reductant can be retinoid, terpenoid or a mixture thereof. Bortlik generally describes a composition as an additive in a foodstuff for oral administration. The composition may contain terpenoid, retinoid, or a mixture thereof.

Nomomura and Bortlik, however, do not teach or suggests a topical pharmaceutical composition comprising "a free base or a pharmaceutically acceptable salt of a dermal cytochrome 450 1A (CYP1A) inhibitor, a carrier for topical application, and a dermatological drug; wherein the dermal CYP1A inhibitor is terpineol and the

dermatological drug is retinoic acid,” as recited in claim 49. Accordingly, Nonomura and Bortlik do not anticipate claim 49.

Moreover, neither Nonomura nor Bortlik renders claim 49 obvious. Both references simply describe compositions that may contain a mixture of terpenoid and retinoid. Neither reference specifically teaches or suggests a combination of terpineol and retinoic acid. Terpenoids are a large and diverse class of naturally occurring organic chemicals similar to terpenes. Retinoids are a class of chemical compounds that are related chemically to vitamin A. Based on the disclosure of Nonomura or Bortlik, one skilled in the art would not at once envisage a combination of retinoic acid and terpineol.


In addition, Nonomura’s system is designed to enhance plant growth. Bortlik’s composition is designed for oral administration. Neither reference teaches or suggests a topical composition, nor a “carrier for topical application,” as recited in claim 49.

Taken together, Applicants respectfully submit that Burger, Nonomura and Bortlik do not anticipate claim 49 or render claim 49 obvious because they fail to teach or suggest every aspect of the claimed invention. Applicants further submit that claim 51 is patentable over Burger, Nonomura and Bortlik because it depends from claim 49 and recites additional patentable subject matter. Withdrawal of the rejection 35 U.S.C. §102(b)/(e) over Burger, Nonomura and Bortlik is respectfully requested.

Claim 50 has been canceled. Rejections to claim 50 are now moot.

In view of the foregoing remarks, favorable reconsideration of all pending claims is requested. Applicants respectfully submit that this application is in condition for allowance and request that a notice of allowance be issued. Should the Examiner believe that anything further is required to expedite the prosecution of this application or further clarify the issues, the Examiner is requested to contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,



Dated: **August 17, 2006**

---

**Fei-Fei Chao**  
Registration No. 43,538  
**Andrews Kurth LLP**  
1350 I Street, NW  
Suite 1100  
Washington, D.C. 20005  
Telephone: (202) 662-3036  
Fax: (202) 662-2739